

DOCKET NO.: Polaroid 8528 (IVBA-0333)
Application No.: 10/067,442
Office Action Dated: November 1, 2006

**PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 C.F.R. § 1.116**

REMARKS

Claims 1 to 8, 10, 12 to 19, 21, 23 to 28, 30 to 38, 42 to 49, 51, 53 to 58, and 60 to 72 are pending in this application and stand finally rejected under 35 U.S.C. § 103(a). Applicant is herein amending claims 1, 14, 25, 31, 44, 55, and 61. Applicant requests entry of the claim amendments and reconsideration of the rejection in light of the amendments and following remarks.

Amendments to Claims

Applicant is herein amending claims 1, 14, 25, 31, 44, 55, and 61 to even more clearly indicate that no input or step of the claimed invention includes information identifying the user. Applicant submits that no new matter is introduced by the amendments to the claims and that the amendments are fully supported by the specification, as originally filed. See, for example, paragraphs [0016] and [0028] that indicate that the input and registration request message do not include information identifying the user.

Applicant requests the entry of the amendment under 37 C.F.R. § 1.116(b) because the amendments to the claims either cancel claims, comply with requirements of form expressly set forth in a previous Office Action, or present the rejected claims in better form for consideration on appeal.

Rejection under 35 U.S.C. § 103(a)

Claims 1 to 8, 10, 12 to 19, 21, 23 to 28, 30 to 38, 42 to 49, 51, 53 to 58, and 60 to 72 stand finally rejected under 35 U.S.C. § 103(a) as allegedly obvious over US-B-6,823,526 (“Howard patent”). Applicant traverses the rejection because the Howard patent does not disclose, teach, or suggest all of the elements of applicant’s claimed invention and there is no disclosure, teaching, or suggestion to modify the cited reference to reach applicant’s claimed invention.

Applicant submits that it has not been established in the Office Action that the claimed invention is *prima facie* obvious. To establish a proper *prima facie* rejection, the following elements must be shown:

- (1) the reference(s) is (are) available as prior art against the claimed invention;
- (2) the motivation (explicit or implicit) provided by the reference(s) that would have rendered the claimed invention obvious to one of ordinary skill in the art at the time of the invention;
- (3) a reasonable expectation of success;
- (4) the basis for concluding that the claimed invention would have been obvious to do, not merely obvious to try; and
- (5) the reference(s) teach(es) the claimed invention as a whole.

Applicant submits that elements 2, 3, 4 and 5 have not been established. Hence, a *prima facie* obviousness rejection is improper. *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1983).

Claim 1, as amended, is directed to a computer implemented method for registering a device, such a printer, with the manufacturer of the device ***without information identifying the user***, such as the user's name and address, in any input or step. As noted earlier, the user of the device provides input to the device, such as by pressing a button on the device. The user input does not include information identifying the user. In response to the user input, the device transmits a registration request message, which also does not include information identifying the user, to a registration server, which receives the message and in response registers the device.

The Office cites the Howard patent as the basis of the obviousness rejection relying on column 7, lines 36 to 40, which describes standard software (an installer 22) that is installed in a computer when a new device such as a printer is installed:

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The installer 22 may also interactively provide the user with merchandising information associated with the external device 30, *such as verification of warranty registration* and software license agreements.

The Office acknowledges that the Howard patent does not expressly disclose registering the device with the manufacturer. The Office reasons that it would have been obvious to register the warranty for a device, if the warranty had not previously been registered, but does not point to any explicit or implicit motivation for this modification to the Howard patent.

Applicant submits that the Office has applied an “obvious to try” standard rather than a proper obvious standard. Furthermore, applicant submits that it is impermissible for the Office to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 USPQ.2d 1780 (Fed. Cir. 1992). The Office cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ.2d 1596, 1600 (Fed. Cir. 1988). The Howard patent itself is silent with respect to how the verification of the warranty registration would be carried out and the Office has not pointed to any motivation in the reference itself or combination with other references that would teach or suggest registering the device *without information identifying the user* in any input or step. Applicant submits that the Office is engaging in the impermissible hindsight construction of the applicant’s claimed invention and is not applying the correct test for obviousness.

In view of the foregoing arguments, applicant submits that the Office has failed to establish a proper *prima facie* obviousness rejection and, therefore, requests the Office to withdraw the rejection of claims 1 to 8, 10, 12 to 19, 21, 23 to 28, 30 to 38, 42 to 49, 51, 53 to 58, and 60 to 72 under 35 U.S.C. § 103(a) over the Howard patent.

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Conclusions

Applicant requests:

- (1) entry of the amendments to the claims;
- (2) reconsideration and withdrawal of the rejection of the claims; and
- (3) allowance of claims 1 to 8, 10, 12 to 19, 21, 23 to 28, 30 to 38, 42 to 49, 51, 53 to 58, and 60 to 72.

If the Examiner is of a contrary view, the Examiner is requested to contact the undersigned attorney at (404) 459-5642.

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